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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL L. LYONS

Appeal 2008-4777
Application 10/724,653
Technology 3700

Decided: December 11, 2008

Before ERIC GRIMES, RICHARD M. LEBVOVITZ, and JEFFREY N.
FREDMAN, *Administrative Patent Judges*.

GRIMES, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to a folding pocket wallet. The Examiner has rejected the claims as anticipated and as lacking a written description in the Specification. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

BACKGROUND

The Specification states that carrying ... a wallet in a rear pocket, especially while seated for prolonged periods, can be a cause of back pain, sciatica and spinal misalignment, and it is thus recommended that one carry the wallet not in the rear pocket” (Specification 1).

“Front pockets are often shaped differently from rear pockets, being tapered toward their closed end” (*id.*). The Specification discloses “a wallet which, when folded, has a tapered end to better fit such a front pocket” (*id.*).

DISCUSSION

1. CLAIMS

Claim 12 is on appeal¹ and reads as follows:

Claim 12: A folding pocket wallet shaped to fit a front trousers pocket, said front pocket wallet, when folded for placement in a front trousers pocket, comprising

- (a) a single fold line at one end;
- (b) two edges adjacent said single fold line, one of said edges being a shorter edge; and
- (c) one end opposite to said single fold line;
said shorter edge having substantially rounded tapering where it joins said end and defining the edge of a money pocket within said folding pocket wallet,
whereby use of said folding pocket wallet obviates spinal misalignment and neural damage.

¹ Claims 13-22 are also pending: Claim 13 stands rejected and claims 14-22 have been objected to (Office Action mailed June 6, 2006, pp. 3-4). Appellant filed an amendment canceling claims 13-22 and adding claims 23-34 (Amendment After Final Rejection, filed Sept. 5, 2006). However, the Examiner did not enter the proposed amendment (Advisory Action mailed Sept. 26, 2006). Because Appellant has not disputed the merits of the rejection of claim 13 set out in the Office Action mailed June 6, 2006, we summarily affirm that rejection.

2. WRITTEN DESCRIPTION

Claim 12 stands rejected under 35 U.S.C. § 112, first paragraph, on the basis that it lacks written description in the Specification (Answer 3).

The Examiner finds that the “original disclosure does not support the **single fold line** at one end” (Answer 3). The Examiner reasons that “the multiple layers would form multiple fold lines at portion 11” (*id.*).

Appellant argues that the “Examiner reads the words ‘fold line’ as being a crease formed after folding in each one of a multiplicity of layers” but that Appellant “selected the words ‘fold line’ to indicate the place or line where the wallet is folded - a place which forms and thereby defines one end of the folded wallet, where prior to folding ... there was merely a region of the unfolded wallet ...” (Appeal Br. 4).

The purpose of the written description requirement is to “ensure that the scope of the right to exclude, as set forth in the claims does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” *Reiffin v. Microsoft Corp.*, 214 F.3d 1342, 1345 (Fed. Cir. 2000). To that end, to satisfy the written description requirement, the inventor must “convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991). “One shows that one is ‘in possession’ of the invention by describing the invention, with all its claimed limitations.” *Lockwood v. American Airlines*, 107 F.3d 1565, 1572 (Fed. Cir. 1997).

We agree with Appellant that the originally filed Specification provides adequate descriptive support for the disputed limitation. The

Examiner's argument is essentially that the term "single fold line" should be interpreted to mean a fold in only one layer versus a "single fold line" that may fold multiple layers.

"[A]s an initial matter, the PTO applies to the verbiage of the proposed claims the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification." *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). Here, the Specification discloses in Figure 1 an embodiment of the invention having multiple layers folded at the same place which is specifically referred to as a "fold line" (Spec. 3: 3-5). Read in light of the Specification, therefore, the broadest reasonable interpretation of the term "single fold line" encompasses a fold line where multiple layers may be folded. Thus, given the wallet illustrated in Figure 1 of the Specification, one of skill in the art would have understood that Appellant was in possession of the wallet of claim 12.

The rejection of claim 12 under 35 U.S.C. § 112, first paragraph, on the basis of lack of written description in the Specification is reversed.

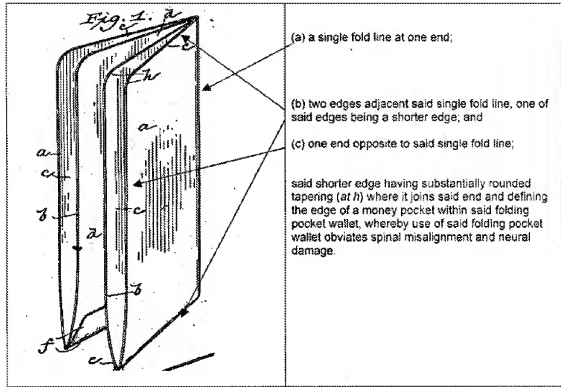
3. ANTICIPATION

Claim 12 stands rejected under 35 U.S.C. § 102(b) as anticipated by Wieland.²

The Examiner sets forth three interpretations of how Wieland discloses the wallet of claim 12, one of which is reproduced below:

² Wieland, US 601,922, Apr. 5, 1898.

Interpretation 1 of Wieland:



(Answer 4.) The Examiner’s diagram shows Fig. 1 of Wieland (i.e., a wallet made from a sheet of material folded twice – first laterally and then vertically – and having one rounded corner opposite the vertical fold line) with the Examiner’s annotation that the vertical fold corresponds to the “single fold line at one end” of claim 12.

The Examiner further finds that the claim language reciting that “the wallet obviates spinal misalignment” is a statement of intended use that does not patentably distinguish the invention of claim 12 from the prior art wallet of Wieland (*id.*).

We agree with the Examiner that Wieland discloses all the limitations of claim 12. Wieland discloses a “pocket-book formed of stiff paper, the ...

paper being folded twice” (Wieland, p. 1, ll. 88-90, and Fig. 1 of Wieland (with the Examiner’s annotations) as set forth above). Wieland also discloses that “[o]ne outer front corner *h* of each fold preferably is rounded ... to remove sharp corners that would be liable to injury” (*id.* at p. 1, ll. 74-76). Thus, Wieland discloses a wallet meeting the limitations of claim 12 as set forth in the Examiner’s “Interpretation 1 of Wieland” (Answer 4, reproduced above).

Appellant argues that the Examiner’s reasoning that the wallet of Wieland has “a single fold line at one end” is in error because Wieland’s “wallet has two fold lines - not one single fold line” (Appeal Br. 11).

We are not persuaded by this argument. Claim 12 specifies that the wallet has a single fold line at one end, but does not exclude the wallet from having fold lines at other locations along its body. The transitional term “comprising” used in claim 12 opens the claim to additional, unrecited elements. *See CIAS, Inc. v. Alliance Gaming Corp.*, 504 F.3d 1356, 1360 (Fed. Cir. 2007). Thus, the pocket-book of Wieland would be reasonably interpreted to meet the limitations of claim 12 because it has a single fold line at one end, as well as two fold lines along the side.

Appellant “agrees with the Examiner in saying Wieland’s corner is ‘substantially round,’” but argues that “[b]eing ‘substantially round ... is totally different from being ‘substantially rounded.’” (Appeal Br. 12). Appellant further argues “‘substantial’ . . . means much more than simply rounding off a corner to protect the corner from damage; it means, for example, half the entire width of the wallet” (*id.* at 13). Appellant concludes

that the claimed invention “uniquely provides substantially rounded tapering, across a significantly broader region, than in any prior wallet” (*id.*).

We are not persuaded by this argument. The Examiner reasonably interpreted the edge “having substantially rounded tapering” to encompass a rounded corner as in Wieland. Because Wieland’s pocket-book edge is depicted as completely rounded off, we agree with the Examiner that it would be “substantially” rounded, contrary to Appellant’s argument (App. Br. 13). Appellant also argues that “substantially round” is different from “substantially rounded tapering” but fails to provide a definition from the Specification or other evidence of this purported difference. Thus, the rounded corner of Wieland would be reasonably construed by one of ordinary skill in the art to be at least one form of substantially rounded tapering, and meet this claim limitation.

Appellant further argues that the “recitation of use as a front pocket wallet in fact does result in structural differences between the invention as claimed and the prior art” (Appeal Br. 15). Appellant also argues that “use as a wallet in a front trousers pocket” provides “extraordinary benefits to spinal alignment, sciatica and neurological health [that] are novel and unanticipated *results* - ... not intended uses” (*id.*).

We do not find these arguments to be persuasive. “Where . . . a patentee defines a structurally complete invention in the claim body and uses the preamble only to state a purpose or intended use for the invention, the preamble is not a claim limitation.” *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997). Claim 12 recites a structurally complete invention; as discussed above, we do not agree that the claimed wallet differs structurally from the

one disclosed by Wieland. The disclosure in the preamble that the claimed product is a “front pocket wallet” is a statement of intended use, not a claim limitation. Further, Appellant’s argument that the use of the claimed wallet provides unanticipated benefits to spinal alignment, sciatica and neurological health is not found to be persuasive because evidence of unexpected results are relevant only to obviousness, not anticipation. *See Cohesive Technologies, Inc. v. Waters*, 543 F.3d 1351, 1364 (Fed. Cir. 2008) (“[O]bviousness requires analysis of secondary considerations of nonobviousness, while secondary considerations are not an element of a claim of anticipation.”)

SUMMARY

The Examiner’s anticipation rejection is supported by the preponderance of the evidence of record, and we therefore affirm the rejection of claim 12 under 35 U.S.C. § 102. However, we reverse the rejection of claim 12 under 35 U.S.C. § 112, first paragraph.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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